

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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JEFFREY SCHWINDT, MICHAEL E. MILLER, JOSEPH L. MARK,  
JOHN P. HANCOCK and CHARLES BUTCHER

Junior Party  
(Application No. 10/936,395),

v.

MICHAEL E. MILLER, JOSEPH L. MARK,  
JOHN P. HANCOCK and CHARLES BUTCHER

Senior Party  
(Patent No. 6,758,824).

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Patent Interference No. 105,805 (SCM)  
(Technology Center 3700)

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DECLARATION – Bd. R. 203(b)<sup>1</sup>

Part A. Declaration of Interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application, patent, count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this DECLARATION.

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<sup>1</sup> “Bd. R. x” may be used as shorthand for “37 C.F.R. § 41.x”. 69 Fed. Reg. 49960, 49961 (12 Aug. 2004).

1           Part B. Judge managing the interference

2           Administrative Patent Judge Sally C. Medley has been designated to manage  
3 the interference. Bd. R. 104(a).

4           Part C. Standing order

5           A Trial Section STANDING ORDER [SO] (Paper 2) accompanies this  
6 DECLARATION. The STANDING ORDER applies to this interference. The  
7 STANDING ORDER has recently been updated. An Executive Summary of  
8 significant changes is provided.

9           Part D. Initial conference call

10          A telephone conference call to discuss the interference is set for 1:30 p.m.  
11 on 12 July 2011 (the Board will initiate the call). The interference is declared to  
12 resolve an apparent inventorship dispute. *Chou v. University of Chicago*, 254, F.3d  
13 1347, 1358 n.2 (Fed. Cir. 2001) (one means for a putative inventor to assert  
14 inventorship rights is to file a patent application and have the PTO declare an  
15 interference to establish inventorship). The parties should be prepared to discuss,  
16 during the conference call, why any issues other than inventorship should be  
17 considered.

18          No later than four business days prior to the conference call, each party  
19 shall file and serve (SO ¶¶ 10.1 & 105) a list of the motions (Bd.R. 120; Bd.R. 204;  
20 SO ¶¶ 104.2.1, 120 & 204) the party intends to file.

21          A sample schedule for taking action during the motion phase appears as  
22 Form 2 in the STANDING ORDER. Counsel are encouraged to discuss the  
23 schedule prior to the conference call and to agree on dates for taking action. A  
24 typical motion period lasts approximately eight (8) months. Counsel should be  
25 prepared to justify any request for a shorter or longer period.

1 Part E. Identification and order of the parties

2 Junior Party

3 Named Inventors: JEFFREY SCHWINDT, Indianapolis, IN  
4 MICHAEL E. MILLER, Trafalgar, IN  
5 JOSEPH L. MARK, Indianapolis, IN  
6 JOHN P. HANCOCK, Fishers, IN  
7 CHARLES BUTCHER, Carmel, IN  
8 Involved Application: Application 10/936,395, filed 8 September 2004  
9 Title: Biopsy apparatus  
10 Assignee: Tissue Extraction Devices, LLC

11 Senior Party

12 Named Inventors: MICHAEL E. MILLER, Trafalgar, IN  
13 JOSEPH L. MARK, Indianapolis, IN  
14 JOHN P. HANCOCK, Fishers, IN  
15 CHARLES BUTCHER, Carmel, IN  
16 Involved Patent: Patent No. 6,758,824 issued 6 July 2004, based on  
17 Application 09/707,022, filed 6 November 2000  
18 Title: Biopsy apparatus  
19 Assignee: Suros Surgical Systems, Inc.

20 The senior party is assigned exhibit numbers 1001-1999. The junior party is  
21 assigned exhibit numbers 2001-2999. Bd.R. 154(c)(1); SO ¶ 154.2.1. The senior  
22 party is responsible for initiating settlement discussions. SO ¶ 126.1.

23 Part F. Count and claims of the parties

24 Count 1

25 Claim 1 of Schwindt's Application or Claim 1 of Miller's Patent

26 Count 2

27 Claim 2 of Schwindt's Application or Claim 2 of Miller's Patent

1	<u>Count 3</u>
2	Claim 3 of Schwindt's Application or Claim 3 of Miller's Patent
3	<u>Count 4</u>
4	Claim 4 of Schwindt's Application or Claim 4 of Miller's Patent
5	<u>Count 5</u>
6	Claim 5 of Schwindt's Application or Claim 5 of Miller's Patent
7	<u>Count 6</u>
8	Claim 6 of Schwindt's Application or Claim 6 of Miller's Patent
9	<u>Count 7</u>
10	Claim 7 of Schwindt's Application or Claim 7 of Miller's Patent
11	<u>Count 8</u>
12	Claim 8 of Schwindt's Application or Claim 8 of Miller's Patent
13	<u>Count 9</u>
14	Claim 9 of Schwindt's Application or Claim 9 of Miller's Patent
15	<u>Count 10</u>
16	Claim 10 of Schwindt's Application or Claim 10 of Miller's Patent
17	<u>Count 11</u>
18	Claim 11 of Schwindt's Application or Claim 11 of Miller's Patent
19	<u>Count 12</u>
20	Claim 12 of Schwindt's Application or Claim 12 of Miller's Patent
21	<u>Count 13</u>
22	Claim 13 of Schwindt's Application or Claim 13 of Miller's Patent
23	<u>Count 14</u>
24	Claim 14 of Schwindt's Application or Claim 14 of Miller's Patent
25	<u>Count 15</u>
26	Claim 15 of Schwindt's Application or Claim 15 of Miller's Patent
27	<u>Count 16</u>

1 Claim 16 of Schwindt's Application or Claim 16 of Miller's Patent

2 Count 17

3 Claim 17 of Schwindt's Application or Claim 17 of Miller's Patent

4 Count 18

5 Claim 18 of Schwindt's Application or Claim 18 of Miller's Patent

6 Count 19

7 Claim 19 of Schwindt's Application or Claim 19 of Miller's Patent

8 Count 20

9 Claim 20 of Schwindt's Application or Claim 20 of Miller's Patent

10 Count 21

11 Claim 21 of Schwindt's Application or Claim 21 of Miller's Patent

12 Count 22

13 Claim 22 of Schwindt's Application or Claim 22 of Miller's Patent

14 Count 23

15 Claim 23 of Schwindt's Application or Claim 23 of Miller's Patent

16 Count 24

17 Claim 24 of Schwindt's Application or Claim 24 of Miller's Patent

18 Count 25

19 Claim 25 of Schwindt's Application or Claim 25 of Miller's Patent

20 Count 26

21 Claim 26 of Schwindt's Application or Claim 26 of Miller's Patent

22 Count 27

23 Claim 27 of Schwindt's Application or Claim 27 of Miller's Patent

24 Count 28

25 Claim 28 of Schwindt's Application or Claim 28 of Miller's Patent

26 Count 29

27 Claim 29 of Schwindt's Application or Claim 29 of Miller's Patent

Count 30  
Claim 30 of Schwindt's Application or Claim 30 of Miller's Patent

Count 31  
Claim 31 of Schwindt's Application or Claim 31 of Miller's Patent

Count 32  
Claim 32 of Schwindt's Application or Claim 32 of Miller's Patent

Count 33  
Claim 33 of Schwindt's Application or Claim 33 of Miller's Patent

Count 34  
Claim 34 of Schwindt's Application or Claim 34 of Miller's Patent

Count 35  
Claim 35 of Schwindt's Application or Claim 35 of Miller's Patent

Count 36  
Claim 36 of Schwindt's Application or Claim 36 of Miller's Patent

Count 37  
Claim 37 of Schwindt's Application or Claim 37 of Miller's Patent

The claims of the parties are:

Schwindt: 1-37

Miller: 1-37

The claim of the party that is found in each count is that party's claim that corresponds to that particular count. For example, claim 1 of the involved application and claim 1 of the involved patent corresponds to Count 1, claim 2 of the involved application and claim 2 of the involved patent corresponds to Count 2, claim 3 of the involved application and claim 3 of the involved patent corresponds to Count 3, and so forth.

1           The claims of the parties which do not correspond to Counts 1-37 are:

2                   Schwindt:   none

3                   Miller:       none

4           The parties are accorded the following benefit for Counts 1-37:

5                   Schwindt:   none

6                   Miller:       none

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1 Part G. Heading to be used on papers

2 The following heading must be used on all papers filed in this interference,  
3 see SO ¶ 106.1.1:

4 UNITED STATES PATENT AND TRADEMARK OFFICE  
5

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11 Junior Party  
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20 (Technology Center 3700)  
21  
22

23 Part H. Order form for requesting file copies

24 When requesting copies of files, use of SO Form 4 will greatly expedite  
25 processing of the request. Please attach a copy of Parts E and F of this  
26 DECLARATION with a hand-drawn circle around the patents and applications for  
27 which a copy of a file wrapper is requested.

28 /Sally C. Medley/  
29 Administrative Patent Judge  
30



1 Enc:

2 Copy of STANDING ORDER (March 2011)  
3 Copy of Executive Summary of STANDING ORDER  
4 Copy of claims of Application 10/936,395  
5 Copy of Patent 6,758,824  
6 Copy of Form PTO-850

7  
8  
9 cc (via overnight delivery):

10 Attorney for Schwindt:

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15 CHICAGO IL 60601  
16

17 Attorney for Miller:

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